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ACACIA MEDIA TECHNOLOGIES CORPORATION

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re: ACACIA MEDIA TECHNOLOGIES CORPORATION PATENT LITIGATION	Case No. C 05-01114 MDL No. 1665 **ACACIA MEDIA TECHNOLOGIES CORPORATION'S MEMORANDUM OF LAW RESPONDING TO THIS COURT'S FEBRUARY 3, 2006 ORDER FOR ADDITIONAL BRIEFING** **DATE:** February 24, 2006 **TIME:** 9:00 A.M. **CTRM:** Hon. James Ware

HENNIGAN, BENNETT & DORMAN LLP
LAWYERS
LOS ANGELES, CALIFORNIA

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Pursuant to this Court's February 3, 2006 Order Requiring Additional Briefing, Plaintiff Acacia Media Technologies Corporation ("Acacia") addresses each of this Court's three issues:

1. Whether the Court should regard the pending motion as one in which Acacia is moving for partial summary judgment against Acacia and in favor of all Defendants on all claims of infringement of the '702 patent on the following ground: Based on the Court's December 7, 2005 Order, the affirmative defense of invalidity is sustained as a matter of law.

Yes, the Court should regard the pending motion as one in which Acacia is moving for partial summary judgment against Acacia and in favor of all Defendants on all claims of infringement of the '702 patent on the following ground: Based on the Court's December 7, 2005 Order, the affirmative defense of invalidity is sustained as a matter of law.

In its December 7, 2005 Order, the Court found:

1. that the claim term "sequence encoder," which appears in independent claims 1 and 17 and in dependent claims 18 and 32, of U.S. Patent No. 6,144,702 ("the '702 patent"), is indefinite;[1] and
2. that the claim term "identification encoder," which appears in independent claims 1, 17, and 27 and in dependent claims 5, 6, 19, and 31 of the '702 patent, is indefinite.

The Court's finding that the term "sequence encoder" in claims 1, 17, 18, and 32 is indefinite and finding that the term "identification encoder" in claims 1, 17, and

[1] The Court did not find the term "sequence encoder" in claims 7 and 33 of the '702 patent to be indefinite and Acacia contends that the term "sequence encoder" in claims 7 and 33 of the '702 patent is definite. Acacia, however, cannot contend that dependent claims 7 and 33 are valid in view of the Court's finding of indefiniteness of the term "identification encoder," which is also present in claims 7 and 33 of the '702 patent.

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27 is indefinite renders all of the claims of the '702 patent (claims 1-42) indefinite, and therefore invalid, under 35 U.S.C. § 112, ¶ 2.

2. Whether the Court should regard the pending motion as one in which Acacia is moving for partial summary judgment against Acacia and in favor of all Defendants on all claims of infringement of the '702 patent on the ground that the accused products of the Defendants do not infringe the '702 patent.

Yes, the Court should regard the pending motion as one in which Acacia is moving for partial summary judgment against Acacia and in favor of all Defendants on all claims of infringement of the '702 patent on the ground that the accused products of the Defendants do not infringe the '702 patent.

In its December 7, 2005 Order, the Court found that the claim phrase "transmission system at a first location," which appears in independent claims 1, 17, and 27 of the '702 patent, means "a transmission system at one particular location separate from the location of the reception system."

The effect of the Court's construction of the phrase "transmission system at a first location" in claims 1, 17, and 27 of the '702 patent is to render all of the claims of the '702 patent (claims 1-42) not infringed by the transmission systems made, used, or sold by the defendants in this case which are located at more than one location. Acacia is aware that defendants utilize transmission systems located at more than one location separate from the location of the reception system. In order to expedite its appeal, Acacia concedes non-infringement of the '702 patent based on this Court's construction of "transmission system at a first location."[2]

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[2] Acacia has not, however, conceded that none of the defendants have a transmission system at only one location separate from the location of the reception system. Acacia has not been able to take any discovery from defendants and therefore has no basis for conceding or contending, and does not concede or contend, that defendants have no transmission systems that are located at more than one location separate from the location of the reception system.

3. Whether any of the issues involved in the '702 patent are present in any of the other patents involved in the MDL case such that the appellate court will not be required to decide the same issues more than once if there are subsequent appeals.

No, none of the issues involved in the '702 patent are present in any of the other patents involved in the MDL case. If the Court enters judgment pursuant to Rule 54(b), the appellate court will not be required to decide the same issues more than once if there are subsequent appeals.

Acacia's appeal of the '702 patent will involve only three indefiniteness and claim construction issues:

1. Whether the claim term "sequence encoder" is indefinite, and, if not, what is the proper legal construction for this claim term?
2. Whether the claim term "identification encoder" is indefinite, and, if not, what is the proper legal construction for this claim term?
3. What is the proper legal construction of the claim phrase "transmission system at a first location?"

If the Court were to grant a Rule 54(b) judgment, the Federal Circuit will not be asked, in a subsequent appeal of another Yurt patent, to decide the purely legal question of the indefiniteness or the proper legal construction of the claim terms "sequence encoder," "identification encoder," or "transmission system at a first location," as these terms do not appear in any other Yurt patent

DATED: February 13, 2006 HENNIGAN, BENNETT & DORMAN LLP

BY: /s/ Alan P. Block
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I am employed in the County of Los Angeles, State of California. I am over the age of 18 years and not a party to the within action; my business address is 865 South Figueroa Street, Suite 2900, Los Angeles, California 90017.

On **February 13, 2006**, I served a copy of the within document(s) described as **ACACIA MEDIA TECHNOLOGIES CORPORATION'S MEMORANDUM OF LAW RESPONDING TO THIS COURT'S FEBRUARY 3, 2006 ORDER FOR ADDITIONAL BRIEFING** on the interested parties in this action by transmitting via United States District Court for the Central District of California Electronic Case Filing Program the document(s) listed above by uploading the electronic files for each of the above listed document(s) on this date, addressed as set forth on the attached Service List.

The above-described document was also transmitted to the parties indicated below, by Federal Express only.

Chambers of the Honorable James Ware
Attn: Regarding Acacia Litigation
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3 copies

I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its Los Angeles office for the collection and processing of federal express with Federal Express.

Executed on **February 13, 2006**, at Los Angeles, California.

I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made.

/S/ Sylvia A. Berson
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